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MAILED

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OFFICE OF PETITIONS

In re Patent No. 6,530,905 :
Issue Date: March 11, 2003 :
Application No. 09/775,239 : DECISION ON PETITION
Filed: February 1, 2001 :
Patentee: Hoomana Asbaghi :

This is a decision on the renewed petition under 37 CFR 1.378(b), filed March 23, 2012, to accept the unavoidably delayed payment of the maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(b) is **DENIED**. This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

The above-identified patent issued March 11, 2003. Accordingly, the first maintenance fee could have been paid during the period from March 11, 2006 through September 11, 2006 without surcharge, or with a late payment surcharge during the period from September 12, 2006 through March 11, 2007. No maintenance fee having been received, the patent expired on March 12, 2007. Patentee filed a petition to accept the unavoidably delayed payment of the maintenance fee under 37 CFR 1.378(b) on January 4, 2012. However, the petition was dismissed in a decision mailed on January 26, 2012.

Applicable Rule, Case Law, Facts, and Analysis:

37 CFR 1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee must include:

- (1) The required maintenance fee set forth in 37 CFR 1.20(e) through (g);
- (2) The surcharge set forth in 37 CFR 1.20(i)(1); and
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The instant petition does not meet requirement (3) above.

With regard to requirement (3), acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 USC 133. **This is a very stringent standard.** Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

Evidence Presented on Petition filed January 4, 2012:

According to petitioner, Nydegger and Associates (hereinafter "Nydegger"), the firm who prosecuted the application, sent a letter to the Patentee on August 1, 2006, reminding Patentee of the requirement to pay the maintenance fee due of \$685. The letter contained a space at the bottom for Patentee to provide

his instructions. Patentee could either place a check mark by the line that read "Please pay the maintenance fee" or could place a check mark by the line that read "Please do not pay the maintenance fee and allow this case to go abandoned". On August 14, 2006, Nydegger received the letter back from Patentee, with a check mark by the line that read "Please do not pay the maintenance fee and allow this case to go abandoned."

As such, Nydegger did not pay the maintenance fee, and the patent expired on March 12, 2007. No further action was taken with respect to the patent by either Nydegger or the Patentee until September 16, 2011. On that date, the Patentee called Nydegger to inquire about reviving the related European patent for the same invention. It was at this point that petitioner states he learned of the expiration of the present U.S. patent. Nydegger provided Patentee with a copy of the August 14, 2006 letter, showing that Patentee had checked the box instructing Nydegger not to pay the maintenance fee for the U.S. patent. At that point, the Patentee claimed that he had checked the wrong box when responding to Nydegger, and included a statement affirming such with the petition filed January 4, 2012. The statement further asserted that English is not the Patentee's first language.

The decision mailed January 26, 2012 explained that the failure to check the correct box and provide instructions for Nydegger to pay the maintenance fee, while arguably unintentional, was not unavoidable within the meaning of 37 CFR 1.378(b). Rather, the error is one that could have been avoided with the reasonable exercise of due care. In addition, the decision noted that the lack of any billing from Nydegger to Patentee for payment of the first maintenance fee would have prompted a prudent and careful person to make inquiry of Nydegger sooner than September 16, 2011, a period of nearly 3 years after the maintenance fee letter was sent.

Evidence Presented on Renewed Petition:

With the instant renewed petition, Petitioner has presented new evidence, discovered subsequent to the January 26, 2012 decision. According to Petitioner, and as set forth in the revised statement by the Patentee, on or about August 10, 2006, the Patentee mailed a check in the amount of \$685 to Nydegger. Nydegger did not realize that the check corresponded to the amount of the maintenance fee for which Patentee had indicated should not be paid. As such, Nydegger cashed the check on approximately August 18, 2006, and applied the proceeds to Patentee's outstanding balance that was owed to Nydegger for

legal services provided in a corresponding Canadian patent.

Opinion:

The failure of the Patentee to provide the correct instructions to Nydegger, specifically, checking the correct line on the August 1, 2006 letter, was not unavoidable. Moreover, that Patentee mailed a check to Nydegger for the maintenance fee, and Nydegger cashed the check without being aware that the check was for the instant patent, does not constitute unavoidable delay. Delay resulting from a failure in communication between a registered practitioner and his client regarding a maintenance fee payment is not unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). See Ray v. Lehman, 55 F. 3d 606, 34 USPQ2d 1786, (Fed. Cir. 1995). That both Nydegger and Patentee failed to take adequate steps to ensure that each fully understood the other party's meaning, and thus, their own obligation in this matter, does not reflect the due care and diligence of prudent and careful persons with respect to their most important business.

Conclusion:

The prior decision which refused to accept under 37 C.F.R. § 1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. For the above stated reasons, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 C.F.R. § 1.378(b). As stated in 37 C.F.R. § 1.378(e), no further reconsideration or review of this matter will be undertaken.

Since this patent will not be reinstated, the \$2690 submitted for the 3.5 year maintenance fee, 7.5 year maintenance fee, and petition surcharge is being refunded under separate cover. The \$400 fee for requesting reconsideration is not refundable.

Telephone inquiries specific to this decision may be directed to the Petitions Attorney Cliff Congo at (571)272-3207.



Anthony Knight
Director
Office of Petitions /
Petitions Officer